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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,819	12/26/2001	Warren S. Barham	N1261-007	4326
32905	7590	11/26/2003		
JONDLE & ASSOCIATES P.C. 9085 EAST MINERAL CIRCLE SUITE 200 CENTENNIAL, CO 80112				
			EXAMINER	
			KUBELIK, ANNE R	
			ART UNIT	PAPER NUMBER
			1638	

DATE MAILED: 11/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/025,819	BARHAM, WARREN S.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Anne R. Kubelik	1638	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 8-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

1. Claims 1-23 are pending.
2. This application contains claims 8-23 drawn to an invention nonelected without traverse in Paper No. 6. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144). See MPEP § 821.01.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 2 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims are drawn to watermelon fruit produced from non-described parent plants, wherein it remains unclear what the identity of the parent plants are, much less what the resultant product fruit would be. The watermelon fruit are not defined by genomic structure or by phenotypic characteristics, and therefore, the claimed invention lacks an adequate written description.

See *University of California v. Eli Lilly*, 119 F.3d 1567, 43 USPQ 2d 1405 (Fed. Cir. 1997), where it states:

[a] written description of an invention involving a chemical genus, like a description of a chemical species, “requires a precise definition, such as by structure, formula, [or] chemical name,” of the claimed subject matter sufficient to distinguish it from other materials.

Therefore, given the lack of written description in the specification with regard to the structural and physical characteristics of the claimed compositions, it is not clear that Applicant was in possession of the genus claimed at the time this application was filed.

4. Claims 3-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. Dependent claims are included in all rejections. The rejection is repeated for the reasons of record as set forth in the Office action mailed 10 June 2003. Applicant’s arguments filed 9 September 2003 have been fully considered but they are not persuasive.

Claims 3-5 lack antecedent basis for the limitation “said diploid short vine pollinator plant” in line 1.

Applicant urges that the phrase refers back to part (a) in claim 1 (response pg 6).

This is not found persuasive because part (a) in claim 1 recites to “plants”.

#### ***Claim Rejections - 35 USC § 102***

5. Claims 1-7 remain rejected under 35 U.S.C. 102(e) as being anticipated by Elmstrom (US Patent 6,355,865, filed 26 May 1999). The rejection is repeated for the reasons of record as set forth in the Office action mailed 10 June 2003. Applicant’s arguments filed 9 September 2003 have been fully considered but they are not persuasive.

Applicant urges that the pollinator plants of the instant invention are marketable and harvestable, while those of Elmstrom are not marketable (response pg 6).

This is not found persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., marketable and harvestable plants or fruit) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

6. Claims 1-2 and 7 remain rejected under 35 U.S.C. 102(b) as being anticipated by Henderson (1997, J. Amer Soc. Hort. Sci. 102:293-297), taken with the evidence of the instant specification. The rejection is repeated for the reasons of record as set forth in the Office action mailed 10 June 2003. Applicant's arguments filed 9 September 2003 have been fully considered but they are not persuasive.

Applicant urges that Sugar Baby and Florida Giant are long vine varieties, which are different than the short vine pollinators of the instant invention (response pg 6).

This is not found persuasive because the instant specification teaches that Sugar Baby is a short vine plant (pg 12, §0012).

#### ***Claim Rejections - 35 USC § 103***

7. Claims 1-4 and 7 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Maynard et al (1992, Acta Hort. 318:169-173) in view of Crall et al (1987, Proc. Fla. State Hort. Soc. 100:251-253), taken with the evidence of the instant specification. The rejection is repeated

for the reasons of record as set forth in the Office action mailed 10 June 2003. Applicant's arguments filed 9 September 2003 have been fully considered but they are not persuasive.

Applicant urges that Maynard discusses production of triploid watermelon but does not disclose short vine pollinators and Crall et al do not disclose triploids at all (response pg 6-7).

This is not found persuasive. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant urges that the rejection was made using an impermissible "obvious to try" standard. Applicant urges that the references do not disclose or suggest using short vine pollinators to produce seedless watermelon (response pg 7).

This is not found persuasive because Maynard et al disclose a method of producing triploid watermelon fruit by pollinating triploid plants with diploid icebox watermelon varieties and Sugar Baby is a commercially popular icebox variety; its is also a short vine plant.

Given that Sugar Baby has high yields and desirable internal fruit characteristics (Crall et al, pg 252, right column, and Tables 1 and 2), its use would allow the grower to make a profit on selling both the triploid and diploid fruit.

Applicant urges that randomly chosen bits of the prior art references were combined using hindsight reasoning (response pg 7).

This is not found persuasive. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight

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reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

***Claim Rejections - 35 USC § 102 / 35 USC § 103***

8. Claim 2 remains rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Parsons et al (1992, Seedless watermelon production, Texas Agri. Ext. Serv. Bull. L-2303, Texas A & M, College Station). The rejection is repeated for the reasons of record as set forth in the Office action mailed 10 June 2003. Applicant's arguments filed 9 September 2003 have been fully considered but they are not persuasive.

Applicant urges that Parsons is a very brief one page summary of seedless watermelon production and does not disclose using diploid short vine pollinators to produce triploid fruit (response pg 8).

This is not found persuasive. As stated above, the claimed watermelon fruit have not been adequately described, given the uncertainty with regard to the phenotypic expression of characteristics in progeny where neither parent has been described by phenotypic or genotypic characteristics. Furthermore, a prior art watermelon fruit having the same characteristics as the claimed watermelon fruit would anticipate the claimed watermelon fruit even if made by a different method (i.e., using different parent plants), and in the present case no characteristics of the claimed watermelon fruit have been set forth. Applicant any triploid watermelon plant and

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diploid short vine pollinator will result in watermelon fruit with a wide range of phenotypic characteristics, wherein it appears that the watermelon fruit fall within this range.

The rejection is made because the Examiner cannot determine whether the prior art possesses the unrecited characteristics. The Examiner does not have sufficient facts to determine whether the watermelon fruit are inherently the same. In addition, the Examiner cannot conclude that the claimed subject matter would have been obvious since it cannot be determined whether the watermelon fruit differ. Where the prior art product seems to be identical, except that the prior art is silent to a characteristic or property claimed, then the burden shifts to Applicant to provide evidence that the prior art would neither anticipate nor render obvious the claimed invention. See *In re Best* 195 USPQ 430, 433 (CCPA 1977).

### ***Conclusion***

9. No claim is allowed.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne R. Kubelik, whose telephone number is (703) 308-5059. The examiner can normally be reached Monday through Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached at (703) 306-3218. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Customer Service at (703) 308-0198.

Anne R. Kubelik, Ph.D.  
November 20, 2003

